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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/537,800	03/29/2000	Steven M.H. Wallman	10392/46901	7334

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KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER

CHOI, KYLE JAEHUN

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 03/13/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/537,800

Applicant(s)

WALLMAN, STEVEN M.H.

Examiner

Kyle J. Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-177 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-177 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The following is an initial Office Action upon examination on the merits. Claims 1-177 are currently pending in this application.

Specification

2. The disclosure is objected to because of the following informalities:

a. On page 1, line 14, "large" is encapsulated in brackets. The normal use of brackets is to indicate deleted words in an amendment. Since it is not apparent why the term "large" is bracketed, applicant is requested to clarify the significance of the brackets or delete the bracketing, or delete the word if applicant intended the word to be deleted.

b. The uses of the trademarks have been noted in this application (e.g. page 8, lines 13 and 16). It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their

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use in any manner, which might adversely affect their validity as trademarks.

Appropriate correction is required.

Claim Objections

3. **Claims 8, 9, 28, 29, 104, 105, 110 and 111** are objected to under 37 CFR 1.75 as being a substantial duplicate of claim 110. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

a. **Claims 8 and 9** recite that a plurality of organization is "communicated" and "rendered" to the user, respectively. The specification only discloses displaying a list of organizations to choose from as the user's affinity group. Hence, it is submitted that there is no difference between "communicating" and "rendering" in the present context and therefore is found to be redundant.

b. **Claims 165 and 166** are similar in nature to claims 8 and 9 discussed above and therefore are considered to be redundant for the same reasons.

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c. **Claims 28 and 29** recite the same limitation and depend from the same base claim. The only difference in the recitation is that claim 29 further recites that the received weight is "from the user". However, based on the specification, it is not understood where else the weight would originate. Therefore, claims 28 and 29 recite the same limitation and are therefore considered redundant.

d. **Claims 104 and 105** are similar in nature to claims 28 and 29 discussed above and therefore are considered to be redundant for the same reasons.

e. **Claim 111** is an exact copy of **claim 110** with both claims being dependent on the same base claim. Applicant is requested to either cancel one of the redundant claims or amend one of the claims to either depend from a different base claim or recite a different limitation.

4. **Claims 110 and 111** are objected to because of the following informalities:

In line 2, "an" between "receiving" and "prioritized" should be changed to --a--.

Appropriate correction is required.

5. Although a best effort has been made by the examiner to address any informality in the application, due to the large number of claims, the examiner may have inadvertently missed

other informalities. Applicant's cooperation is requested in reviewing the claims to make any corrections necessary to comply to the formalities required under the rules.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 8** and **9** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. As to **claim 8**, it is vague and indefinite as to how "a plurality of organization" is "communicated" to the user. For examination purposes, this limitation is construed as reciting that "a list" of a plurality of organization is communicated to a user for selection.

b. As to **claim 9**, it is vague and indefinite as to how "a plurality of organization" is "rendered" to the user. For examination purposes, this limitation is construed as reciting that "a list" of a plurality of organization is rendered to a user for selection.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. **Claims 160-177** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In particular, claims 160-177 recite that the claimed invention is a "vote" generated by the recited steps. A "vote" is not a process, machine, manufacture, or composition of matter. A "vote" is an abstract idea that conveys a person or entity's desire or preference. Examiner notes that the claimed invention is not a method for generating a vote (i.e., a process) or a "ballot" used in voting (i.e., article of manufacture). Rather, the claimed invention is the "vote" itself. Therefore, it is respectfully submitted that a "vote" is not a statutory subject matter for a patent.

10. **Claims 1-177** are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility for the following reasons.

Applicant notes in the background of the specification that it is old and well known to vote proxies electronically.

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According to the applicant, the shortcomings of the prior art proxy voting system is that the prior art "requires" the shareholder's attention to the proxy statements and the corporate actions that are up for vote before the shareholder can vote his or her proxies. Apparently, the invention of the present application can remove this requirement by assigning preferences to the computer to make the votes on behalf of the shareholder. It is this examiner's position that the prior art systems require shareholders' attention to the proxy statements because for a vote to be valid, the shareholder must make the vote based on an informed decision. Applicant's apparent improvement undermines the validity of the votes thereby generating votes that are all invalid.

To explain further, the invention of the present application is not directed to voting proxies electronically - the invention goes beyond an electronic proxy voting systems, which are already well known in the art. The invention of the present application is directed to an "automated" proxy voting by a computerized system (i.e., the computer system automatically votes on behalf of a shareholder without the shareholder's attention to the corporate actions being placed for vote) based on shareholders' "preferences". These preferences are not the shareholders' preference on what the

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vote should be (i.e., shareholders pre-selecting how each corporate action should be voted and the computer system merely filling out the electronic proxy vote forms automatically).

Rather, the "preferences" in the invention is the shareholders' general preferences of shareholders' "preferred ideas" (e.g., in favor of Green Peace's philosophy) and allowing the computer to vote the shareholders' shares based on these preferred ideas.

In the current practice, the only way a non-shareholder can vote on behalf of a shareholder is by conveying the legal title of the shares to the person or entity that will be voting on the shareholders' behalf. This practice is typically in the form of a voting trust established by the shareholder with a trustee. Otherwise, the shareholder must vote for those votes to be valid. In the invention of the present application, it is not clear how the invention has utility in generating valid votes on behalf of the shareholder.

Firstly, it is not possible to convey legal title of the shareholder to a computer. Therefore, a computer cannot vote "on behalf" of the shareholder. Again, this is different than prior art systems that will take shareholders' votes ahead of time and automatically fills in the electronic proxy vote forms. Applicant's invention allows the computer to vote on behalf of the shareholders.

Secondly, a different aspect of the invention in the present application facilitates third parties to vote for the shareholders. That is to say, the invention of the present application apparently allows the shareholder to set the computer to vote either in accordance with or in opposition to recommendations from a third party (i.e., the "affinity groups"). By allowing the computer to vote the shareholders' votes in accordance with a third party's recommendation, it is in effect giving the voting power to the third party since the purpose of the present invention is to vote the shareholders' proxies without requiring their attention. This aspect of the invention bypasses the rigorous rules for requiring issuance of "voter trust certificates" to non-shareholders who vote to ensure that the non-shareholder casting the vote is a proper voting entity to determine validity of the vote.

The end result of the above discussion is that the invention of the present application does not generate valid votes since the shareholders are not casting the votes and no valid voting trust is established for the others (be it the computer or the third parties) to vote on behalf of the shareholders. Therefore, it is respectfully submitted that the invention as claimed do not have a patentable utility.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. **Claims 146-149** are rejected under 35 U.S.C. 102(b) as being anticipated by **ProxyEdge 2000** (submitted by applicant).

Specifically, **claims 146** and **153** recites communicating a corporate voting form to a shareholder and receiving the user's vote from a service that votes the user's shares. It is respectfully submitted that this claim is reciting the nature of a proxy vote. A proxy service basically collects the shareholder's proxy cards indicating the shareholder's votes and then actually makes the vote on behalf of the shareholder at the meeting. ADP is the proxy service that collects the shareholder's vote forms electronically through ProxyEdge 2000 and sends the vote to the actual proxy who will be making the vote according to the proxy vote forms thereby anticipating claim 146 (Note: there is no automatic voting recited). ProxyEdge 2000 teaches that the forms are communicated electronically as recited in claims 147-149, 154-156.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims 1-7, 10, 12, 13, 15-17, 22, 48-50, 57, 72-81, 87, 89, 90, 92-94, 99, 117-119, 122, 126 are rejected under 35 U.S.C. 103(a) as being unpatentable over ***ProxyEdge 2000*** (submitted by applicant) in view of ***Hosken*** (US Pat. No. 6,438,579)

Before presenting the rejections on the claims, it is noted that the premise of the following rejection is based on the assertion that "voting based on a user-specified preference" is construed as any automated action based on a decision that the computer has made based on some preferential information obtained from the user. The claims in the present application happens to be in the field of corporate voting, but it is this examiner's position that the methodology and the technology

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employed in the claimed invention is based on old and well known computer-based decision making based on user set preferences used in the field of making decisions on electronically transmitted corporate action.

As to **claims 1, 48, 72, 117, 160**, *ProxyEdge 2000* teaches a computer system that collects electronic proxy cards in a computer to allow the user to make the desired selection of corporate actions through a computer. *ProxyEdge 2000* clearly teaches that is was well known to one of ordinary skill in the art at the time of the invention that voting on corporate actions were moving onto a computerized format, allowing distribution and collection of corporate votes electronically. *ProxyEdge 2000* fails to teach that the votes are performed automatically based on user-set preferences.

Hosken teaches receiving preferences from the user on how the user wants the computer to make a decision (col. 10, lns. 39-49) and automatically choosing (i.e., voting) a selection based on user's preferences. (col. 13, lns. 51-59). Although the context of *Hosken* is that the user sets preferences of an interest in specific types of musical products and allowing the system to automatically choose a musical product based on a recommendation, *Hosken* clearly teaches that the technology of using a computer to take action based on a decision arrived

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based on user specified preferences was well known at the time of the invention.

It would have been obvious for one of ordinary skill in the art at the time of the invention to have used the well known technology of using computerized decision making based on user-set preferences (as taught by Hosken) to decide on corporate actions (as taught by ProxyEdge 2000) because corporate voting is nothing more than decisions made based on user preferences in the corporation context. It was well known to one of ordinary skill in the art at the time of the invention that the technology of automating decision making based on user-set preferences were well known and that such technology can be applied to various applications (e.g., music selection for Hosken, trading stocks for Ray et al. (US Pat. No. 6,018,722), cited below). Since voting of corporate action taking is really old and well known and ProxyEdge 2000 teaches moving such activity onto a computerized format, it would have been obvious to one of ordinary skill in the art to have used the well known technique of computer-based decision making based on user-set preferences to automate what was otherwise a manual activity beginning to move onto a computerized format. Merely using a computer to automate a known process does not by itself impart

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nonobviousness to the invention. See MPEP §2144.04(III), citing *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

As to **claims 2-5, 22, 49, 50, 57, 78-81, 99, 118, 119, 126, 163, 164**, ProxyEdge 2000 already teaches an electronic voting form to be filled out by the user and sending the vote electronically to the corporation. Hence, the combination of ProxyEdge 2000 with automatic selections made by a computer based on user-set preferences as indicated above renders automatically making selections on an electronic voting form obvious and therefore unpatentable.

As to **claims 6, 7, 73, 75, 76, 161, 162**, Hosken teaches receiving and storing the user's preferences in a database (Fig. 1A, element 24).

As to **claims 10, 12, 13, 15, 87, 89, 90, 92, 122, 134, 135, 138-141, 144, 145, 168**, Hosken teaches providing recommendations on which the automated decision is based (see at least col. 13, lns. 52-58) and the recommendations are stored (see at least col. 8, lns. 43-44).

As to **claims 16, 17, 93, 94**, Hosken teaches displaying multiple preferences that the user can select to indicate the preferences (col. 10, lns. 39-48).

As to **claim 74**, ProxyEdge 2000 teaches receiving a voting ballot, which would inherently describe the corporate actions one, which the votes are to be based.

As to **claim 77**, Hosken teaches collecting the preferences before the automated selection is made (col. 4, lns. 46-49). It would have been obvious to one with ordinary skill in the art that the preferences must be received before the automated action on which it would be based needs to be effectuated.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Ray et al. (US Pat. No. 6,018,722) discloses another application of automated "voting" system (i.e., automated selection) based on user-set preferences, in this case for purchases of stock shares based on recommendations from different financial groups.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Kyle J. Choi** whose telephone number is (703)306-5845. The examiner can normally be reached on Monday-Friday, 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Tariq Hafiz** can be reached on (703)305-9643.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to:

(703)305-7687 [**Official** communications; including
After Final communications labeled
"Box AF"]

(703)746-5548 [**Informal/Draft** communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park
5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.



KYLE J. CHOI
PRIMARY EXAMINER

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March 7, 2003